

Claim 9 (Original) The surface-modified, pyrogenically produced oxides according to claim 8 wherein the type D4 cyclic polysiloxanes is octamethylcyclotetrasiloxane.

REMARKS

Reconsideration is respectfully requested in light of the foregoing Amendment and remarks that follow.

Claims 1-9 are before the Examiner.

Claims 3, 8 and 9 have been amended to address the objections raised by the Examiner on page 2 of the Official Action.

Claim 3, 8 and 9 are rejected under 35 U.S.C. 112 second paragraph as failing to particularly point out and distinctly claim the subject matter. Applicants respectfully traverse.

The claims have been amended to address the points raised in the Office Action with the exception of specifying a specific range for the "x" in S_x , identified in f), g), h), i) and j). It is believed that the range should be "1-10". However, express support for this range can not be readily found in the specification as filed. The contents of the priority document are expressly incorporated by reference. It is respectfully requested that this requirement for a range for "x" be held in abeyance until the translation is obtained and reviewed. It is clear, however, from the specification as filed that "one or more" S atoms is intended. It is also clear that conventional agents of this type are envisioned as being suitable.

Please note that "0.1-20" contains a typo. It should read "0, 1-20", which is intended to mean "0, or 1-20". The claims have been amended to reflect this. As to the other points, withdrawal of the rejection is respectfully requested in light of the amendments made.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as unpatentable over Deller et al (U.S. Patent No. 5,776,240) in view of Mangold et al. (CA 2,223,377). Applicants respectfully traverse.

It is respectfully submitted that the Examiner has not established a proper prima facie case of obviousness. It appears that the Examiner has relied on hindsight to combine the references since it is not clear why one considering the Deller et al., a process for forming granules, suitable for use as a catalytic support, from pyrogenically prepared silicon dioxide would necessarily look to Mangold et al., a doping process. There is no common problem for which one reference teaches a solution.

Deller et al teaches the interaction of particles and aggregates to form agglomerates. It is not apparent from Deller et al. why there would be a need for doping. It is not clear how a metal layer would be looked to and be reasonably expected to enhance the agglomeration process taught by Deller et al.

Mangold et al teach a aerosol process for the doping, which leads to a nearly homogeneous doping of pyrogenically-prepared oxides. The "end use" mentioned in the Abstract is as a filler. Other uses are mentioned on page 4 at lines 10 et seq. including those as supports and catalytically active material. There is no mention of a combination of treatments with doping. A discussion of enhanced properties resulting from the Mangold et al process appears on page 15. It is not clear from the document if these enhanced properties can be achieved if other treatments, e.g. surface treatments, are also employed along with the doping process.

Accordingly, since Mangold does not teach a suggest a problem for which doping is a solution, it appears that the Examiner is relying on hindsight to combine the references. This is not proper and does not establish a prima facie case. Withdrawal of the rejection is respectfully requested.

Claims 1-3, 5, 8, and 9 are rejected under 35 U.S.C. 103(a) as unpatentable over Laufer et al. (U.S. Patent No. 4, 022,152) in view of Mangold et al. (CA 2,223,377). Applicants respectfully traverse.

It is respectfully submitted that a proper prima facie case of obviousness is not established by the art relied upon. On their face, the references do not suggest their combination. There is no problem apparent in the primary reference teaching of a continuous surface treatment process for which doping is an apparent solution. Therefore, the Examiner appears to be relying on impermissible hindsight to combine the references.

Laufer et al. is concerned with the "absolute drying" of the oxide particles, which step enhances surface quality which results in the formation of superior adsorptive bonds with the organosilicon compound and which promotes an optimal covering of the surface. This results from the formation of a highly active aerogel, which is outstandingly sensitive to reactive materials and is eminently suitable for reaction with an agent which imparts hydrophobic properties. The nature of this drying step is disclosed as permitting both the drying process and the reaction which imparts hydrophobic character to the particles to take place in a single apparatus which permits continuous operation.

Mangold et al. is discussed above. The Examiner correctly notes in the Action that Laufer et al. fails to teach a pyrogenic silica doped by an aerosol. While Mangold et al do teach aerosol doping, it does not suggest its combination with Laufer et al. There is no taught problem in Laufer et al for which doping appears to be a solution. Further, it is noted that solutions of metal salts are used in the Mangold et al. aerosol doping process. This appears to be inconsistent with "absolute drying conditions." This would also be inconsistent with the continuous operation envisioned by Laufer et al. Accordingly, it is not clear why one would add a step or employ conditions that would impact continuous operation which is taught by Laufer to be desirable.

Accordingly it appears that the Examiner is relying on hindsight to combine the references. Further, it appears that the combination of reference would mitigate against continuous operation. A prima facie case is not established. Withdrawal of the rejection is respectfully requested.

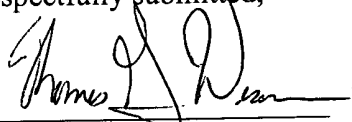
In view of the foregoing amendments and remarks, the application is believed to be in condition for allowance and a notice to that effect is respectfully requested.

The additional art cited by the Examiner has been considered.

Should the Examiner not find the Application to be in allowable condition or believe that a conference would be of value in expediting the prosecution of the Application, Applicants

request that the Examiner telephone undersigned Counsel to discuss the case and afford Applicants an opportunity to submit any Supplemental Amendment that might advance prosecution and place the Application in allowable condition.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas G. Wiseman', written over a horizontal line.

Thomas G. Wiseman
(Registration No. 35,046)

VENABLE

Post Office Box 34385

Washington, DC 20043-9998

Telephone: (202) 962-4800

Direct dial: 202-513-4614

Telefax : (202) 962-8300

DC2-DOCS1-486510